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SMX 3104 (2000-108)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit 1743

Application of Dales, et al.

Patent No. 6,759,014

Issued July 6, 2004

Confirmation No. 7959

For APPARATUS AND METHODS FOR PARALLEL PROCESSING OF MULTIPLE
REACTION MIXTURES

Examiner Arlen Soderquist

July 14, 2004

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 CFR 1.705(d)

TO THE COMMISSIONER FOR PATENTS,

SIR:

Applicants respectfully request reconsideration of the patent term adjustment determination of six hundred and fifty-four (654) days in the Issue Notification dated June 17, 2004. Pursuant to 37 CFR 1.705(b)(2), Applicants submit the following statement of facts in support of this request.

According to §§ 1.702 and 1.703, the correct patent term adjustment should be seven hundred and nine (709) days.

The subject application was mailed on January 26, 2001. According to 37 C.F.R. §1.702(a) (1), a first notification under 35 U.S.C. §132 or a Notice of Allowance under 35 U.S.C. §151 was due fourteen (14) months from that date, March 26, 2002. In fact, the Notice of Allowance was mailed on March 4, 2004, seven hundred and nine (709) days past the fourteen (14) month due date. The Office calculates this portion of the adjustment correctly.

Included in the Notice of Allowance, the Examiner made the following explicit requirement of Applicants:

During a telephone conversation with Brian P. Klein on March 4, 2004 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-25. **Affirmation of this election must be made by applicant in replying to this Office action.**

(emphasis added). In accordance with the Examiner's explicit instructions, Applicants affirmed the election in a letter mailed to the Office on May 13, 2004, along with the issue fee. It appears that the Office has incorrectly considered this paper, which was required by the Examiner after the Notice of Allowance, as an "other paper" submitted after a Notice of Allowance under §1.704(c)(10). This characterization of Applicants response is incorrect. Section 1.704(c)(10) is designed to penalize Applicants who submit papers after the Notice of Allowance that constitute a failure to engage in reasonable efforts to conclude prosecution under the general principles of 35 U.S.C. §154(b)(2)(C)(i). Section 1.704(c)(10) is clearly not designed to penalize Applicants who respond to an Examiner's request in a timely fashion at the first opportunity available to them.

The Office has clarified this rule in the past to give examples of what papers filed after the Notice of Allowance do or do not cause a substantial interference and delay in the patent issue process. According to the "Clarification of 37 CFR § 1.704(c)(10)" published in the Official Gazette on June 26, 2001, the submission of the following papers after the Notice of Allowance will not constitute a failure to engage in reasonable efforts to conclude prosecution: (1) Issue Fee Transmittal, (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interest. On the other hand, the Clarification notes that submission of the following papers after the Notice of Allowance will constitute a failure to engage in reasonable efforts to conclude prosecution: (1) a request for a refund, (2) a status letter, (3) 312 amendments, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

Although the clarification does not specifically address the issue at hand (an election affirmation required by the Examiner in response to a Notice of Allowance issued the same day as an Examiner telephone call seeking the election), the election affirmation submitted by Applicants is clearly similar to the first group of papers that do not constitute a failure to engage in reasonable efforts to conclude prosecution. First, the prosecution was not delayed. Applicants responded to the Examiner's request with the payment of the issue fee. Because the Notice of Allowance was mailed on the same day as the phone conference with the Examiner, Applicants

had no opportunity to affirm the election until after the Notice of Allowance was received by Applicants, several days after issuance of the Notice. Applying the rule as the Office has done, therefore, means that a verbal election associated with a Notice of Allowance automatically results in some loss of additional term. This is clearly unfair and contrary to the intent of the rule. Second, the affirmation of the previous election is merely a formality confirming the earlier decision to elect the allowed claims and does not slow prosecution. Here, the patent issued fifty-five (55) days later, which is no more time than if the issue fee had been filed alone. Third, an election affirmation is very similar to responding to Examiner's reasons for allowance, another paper that does not constitute a failure to engage in reasonable efforts to conclude prosecution.

Thus, Applicants respectfully request that the reduction of fifty-five (55) days (May 13, 2004 to July 6, 2004) be removed from the PTA calculation. This correction should bring the total patent term adjustment to seven hundred and nine (709) days.

There were no circumstances constituting a failure by the Applicants to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 CFR 1.704.

There is no terminal disclaimer in this case.

In light of the foregoing facts, Applicants respectfully request a patent term adjustment of seven hundred and nine (709) days. Please charge deposit account No. 50-0496 in the amount of \$200 to pay the fee required by 37 CFR §1.18(e). Please charge any underpayment or credit any overpayment to deposit account No. 50-0496.

Respectfully submitted,



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